



# UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. <i>mk</i>
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<input type="checkbox"/> <i>10/27/03</i>	<input type="checkbox"/>
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: *10/27/03*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit  
1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135 (a). In no event, however, will a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory period of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to be deemed ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 28, 2001
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, no prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 111, 50 G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-30, 32-43, and 68-73 \_\_\_\_\_ pending in the application.
- 4a) Of the above, claim(s) 25-28, 32-43, and 68-71 \_\_\_\_\_ withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29, 30, 72, and 73 \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to prior art search and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Applicant's file.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(a).

## Attachment(s)

- |     |  |     |   |
|-----|--|-----|---|
| 15) | Notice of References Cited (PTO-892)                       | 18) | Interview Summary (PTO-413)                     |
| 16) | Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 19) | Notice of Informal Patent Examination (PTO-152) |
| 17) | Information Disclosure Statement(s) (PTO-1449) Paper No.s: | 20) | Other   |

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### Part III DETAILED ACTION

#### *Drawings*

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### *Claim Rejections - 35 USC § 112*

2. Claims 29-30 and 72-73 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The claims now recite the preamble phrase "consisting essentially of" and applicants state that the effect of this phrase is "to exclude components like alpha acid which are deleterious to light stability."

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 29-30 and 72-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Vitzthum for the reason set forth in the last Office Action.

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Applicants assert that the amended claims obviate the previous rejection based on Vitzthum because the newly added claim preamble phrase "consisting essentially of" and applicants state that the effect of this phrase is "to exclude components like alpha acid which are deleterious to light stability." Applicants go on to state that the composition of Vitzthum contains alpha acids (that are inherently light unstable). As cited to in the last Office Action, the "hops **liberated of the total resin** . . . can then be extracted in a known manner in an aqueous phase . . . ; the solution is concentrated . . . ." Col. 3, lines 46-49. Further, the "water extract thus obtained . . . can then be used [] alone . . . ." Col. 3, lines 59-63. These extracts will contain no alpha acids that would cause it to be light unstable. Again, certain limitations are of a process nature and are not given patentable weight without a showing of their criticality.

6. Again, the Office does not have the facilities for examining and comparing Applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed are functionally different than those taught by the prior art and to establish patentable differences. See *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 1977); *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1923 (BPAI).

### *Conclusion*

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7. No claim is allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 8:00 to 5:30. The fax phone number for this Group is (703)-305-3602.

10. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



Curtis E. Sherrer  
Primary Examiner  
August 30, 2001